

REMARKS

In view of the foregoing amendments and the following remarks, Applicant respectfully requests reexamination of the present invention. Claims 12-31 are currently pending in this application.

Applicant appreciates Examiner Casca's participation in the telephonic interviews on September 10, 2008 and on September 16, 2008. As discussed with Examiner Casca, Applicants have made an earnest effort to amend the claims to overcome the outstanding rejections and place the application in condition for allowance. Further, Examiner Casca indicated that the above claim amendments would likely overcome the outstanding rejections under 35 U.S.C. 103.

Rejections under 35 U.S.C. §103

Claims 12-14, 18-19 and 23-31 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,289,223 to Mukherjee (Mukherjee) in view of U.S. Patent No. 6,493,559 to Pecen et al. (Pecen). Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Pecen, and further in view of U.S. Patent No. 5,515,421 to Sikand et al. (Sikand). Claims 16, 17 and 20-22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Pecen, and further in view of U.S. Patent No. 5,974,308 to Vedel (Vedel).

Claims 12-17:

Independent Claim 12 recites a process of allowing direct access for individual subscribers to a digital cellular phone network with existing cell broadcast services. Initially, the method accepts a point-to-point short message from a cellular phone equipped to exchange point-to-point short messages with a short-message center over a cellular phone network. A coupling instance is then provided that is interconnectable with the short-message center, and then at least one of a test, an adjustment and a conversion of the point-to-point short message necessary to convert the point-to-point short message into a cellular broadcast message in the coupling instance is completed.

Finally, the cellular broadcast message is forwarded to a cell broadcast center by means of a process that applies to the cell broadcast center such that the cellular broadcast message is broadcast to subscribers within a defined area of the cell broadcast center but is not capable of being broadcast to fewer than all of the subscribers within the defined area of the cell broadcast center.

Mukherjee discloses a system and method in a telecommunications system for enabling an originating mobile unit to deliver Short Message Service (SMS) messages to a *select* plurality of destination mobile units. More specifically, an originating Short Message Entity (SME) or mobile phone (12) initiates an SMS message while designating a destination MSISDN identifier (usergroup of subscribers). This message is eventually transmitted to a Service Center (SC) (18) and a Short Message Service/Gateway Mobile Services Switching Center (SMS-GMSC) (20), one of which stores a multipoint usergroup database (26). If the SC identifies a match between the destination MSISDN and a given usergroup MSISDN within the database and the originating MSISDN has permission to transmit such a message, transmission to the usergroup is initiated.

In the present response, Applicant has amended Claim 12 to recite that in the forwarding step, the process is not capable of being broadcast to fewer than all of the subscribers within the defined area of the cell broadcast center. Conversely, in Mukherjee, the method *is* capable of being broadcast to fewer than all of the subscribers within a defined area of the cell broadcast center. As previously described, in Mukherjee, a SMS subscriber can designate a usergroup MSISDN to transmit an SMS message to a *select* number of subscribers. In fact, Mukherjee specifically indicates a need in the SMS field to allow an SMS subscriber to specify a number of other SMS subscribers to receive a given communications *without* having to transmit to all possible SMS subscribers (lines 60-63 of column 1).

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Moreover, if the proposed modification or combination of

the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959);.

Here, while Pecen teaches the general concept of broadcasting messages to all receivers within a specific geographic region (lines 23-32 of column 1), modifying the system and method of Mukherjee so that it is just not capable of being broadcast to fewer than all of the subscribers within the defined area of the cell broadcast center as required in Independent Claim 12 would completely destroy the system and method of Mukherjee; one of the primary goals of the system and method of Mukherjee *is* to allow a subscriber to transmit an SMS message to fewer than all of the subscribers in a cell broadcast center area.

Even though Mukherjee does not say, as the Examiner states, "that broadcast transmission is bad and should be avoided at all times", Mukherjee also requires that SMS messages are at least *capable of* being transmitted to fewer all of the subscribers within a defined area of the cell broadcast center, because this is a primary goal of the system and method of Mukherjee (see, Title, Abstract, Summary and Detailed Description).

Further, although the Examiner states the advantage of broadcasting to all subscribers in emergency situations thus providing a motivation to combine the invention of Mukherjee with the teaching of Pecen, such an advantage ceases to provide motivation when doing so would destroy the primary reference, as it does in this case.

Therefore, because Mukherjee fails to at least teach that in the forwarding step, the process is not capable of being broadcast to fewer than all of the subscribers within the defined area of the cell broadcast center, and because modifying the system and method of Mukherjee with Pecen would render Mukherjee unsatisfactory for its intended purpose and change its principle of operation, then there is no suggestion or motivation to make the proposed modification and the teachings of the references are not sufficient

to render Independent Claim 12 *prima facie* obvious. Accordingly, Applicant respectfully requests that Independent Claim 12 be indicated as allowable.

Claims 13 - 17 depend from independent Claim 12 and inherit all of the novel and non-obvious features of Claim 12. Accordingly, Applicant additionally respectfully requests reconsideration and allowance of claims 13 - 17.

Claims 18-25:

Independent Claim 18 recites a device for allowing direct access for individual subscribers to a digital cellular phone network with existing cell broadcast services. The cellular phones of the subscribers are equipped to exchange point-to-point short messages with a short message center over the cellular phone network, whereby short messages declared cell broadcast messages are forwarded to a cell broadcast center to be broadcast to the subscribers within a defined area of the cell broadcast center. However, the cell broadcast messages are not capable of being broadcast to fewer than all of the subscribers within the defined area of the cell broadcast center. The device includes means of doing at least one of: a test, an adjustment, and a conversion of the point-to-point short message necessary to convert the point-to-point short message into a cellular broadcast message.

Mukherjee teaches the same invention as previously described.

In the present response, Applicant has amended Claim 18 to recite that the cell broadcast messages are not capable of being broadcast to fewer than all of the subscribers within the defined area of the cell broadcast center. As previously described, the messages in the system of Mukherjee are capable of being broadcast to fewer than all of the subscribers within a defined area of the cell broadcast center. In Mukherjee, a SMS subscriber can designate a usergroup MSISDN to transmit an SMS message to a *select* number of subscribers. In fact, Mukherjee specifically indicates a need in the SMS field to allow an SMS subscriber to specify a number of other SMS subscribers to receive a given communications *without* having to transmit to all possible SMS subscribers (lines 60-63 of column 1).

Because Mukherjee fails to at least teach that messages are not capable of being broadcast to fewer than all of the subscribers within the defined area of the cell broadcast center, and because modifying the system of Mukherjee with Pecen would render Mukherjee unsatisfactory for its intended purpose and change its principle of operation, there is no suggestion or motivation to make the proposed modification and the teachings of the references are not sufficient to render Independent Claim 18 *prima facie* obvious. Accordingly, Applicant respectfully requests that Independent Claim 18 be indicated as allowable.

Claims 19-25 depend from independent Claim 18 and inherit all of the novel and non-obvious features of Claim 18. Accordingly, Applicant additionally respectfully requests reconsideration and allowance of claims 19-25.

Claims 26-31:

Independent Claim 26 recites a method of providing a cellular broadcast center with a cellular broadcast message. The method includes forwarding the cellular broadcast message to a cellular broadcast center to be broadcast to the subscribers within a defined area of the cell broadcast center. In the forwarding step, the cellular broadcast center is not capable of broadcasting the cellular broadcast message to fewer than all of the subscribers within the defined area of the cell broadcast center.

In the present response, Applicant has amended Claim 25 to recite that the cell broadcast center is not capable of broadcasting the cellular broadcast message to fewer than all of the subscribers within the defined area of the cell broadcast center. As previously described, the messages in the system of Mukherjee are capable of being broadcast to fewer than all of the subscribers within a defined area of the cell broadcast center. Because modifying the system of Mukherjee with Pecen would render Mukherjee unsatisfactory for its intended purpose and change its principle of operation, there is no suggestion or motivation to make the proposed modification and the teachings of the references are not sufficient to render Independent Claim 25 *prima facie* obvious. Accordingly, Applicant respectfully requests that Independent Claim 25 be indicated as allowable.

Claims 27-31 depend from independent Claim 26 and inherit all of the novel and non-obvious features of Claim 26. Accordingly, Applicant additionally respectfully requests reconsideration and allowance of claims 27-31.

CONCLUSION

Based upon the foregoing, and because there are no other outstanding rejections or objections, Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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